

Appl. No.: 09/663,963
Response dated October 28, 2003
Reply to Office action of June 3, 2003

Remarks/Arguments

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

Claims 14-28 are pending in this application.

Claims 1-13 have been cancelled. New claims 14-28 have been added. No new matter is thought to be introduced thereby.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

Claims 1-3, 6-7 and 10-13 are rejected under 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed for the following reasons.

Appellant would like to note that it is well settled that claim terminology is sufficiently definite under 35 U.S.C. § 112, second paragraph, unless there is an unreasonable degree of uncertainty in view of the specification and the art as to what is being claimed. See, In re Johnson and Farnum, 194 USPQ 187, 193 and 194 (CCPA 1977)(emphasis added). Thus, resort may be had to the usage of terms in the art to determine the definiteness of claim terminology.

Appellant respectfully submits that the objected to phrase is clear as to its meaning, as presented, and that it satisfies all of the requirements under section 112, second paragraph. Based on the plain meaning of the words, the biotin should be substantially free of particles which include extraneous materials and contaminants, as well as, bacteria.

The meaning of this phrase is eminently clear to those having ordinary skill in the art, when read in light of both the specification and what is known in the art. "The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification." See, *Miles Laboratories Inc., v. Shandon Inc.*, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993). Clearly, such is the case here. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Appl. No.: 09/663,963
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Claims 1-3, 6-7 and 12 are newly rejected under 35 U.S.C. § 102(b) as anticipated by Wickerham (J. Bacteriology, 1946, Vol. 52, pgs. 293-301). This rejection is respectfully traversed for the following reasons.

Initially, Applicant would like to note that claims 1-3, 6-7 and 12 have been cancelled, without prejudice. Therefore, the Examiner's rejection is rendered moot with respect to those claims. Next, Applicant would also like to note that it is very well settled that a factual determination of anticipation requires the disclosure, in a single reference, of each and every element of the claimed invention, and an Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. See, In re Levy, 17 USPQ2d 1561 (Bd. Pat. App. & Inter. 1990).

Applicant respectfully submits that the Wickerham reference fails to anticipate the newly claimed invention on the grounds that it fails to disclose each and every element thereof. More particularly, nowhere within the four corners of the Wickerham does there appear any disclosure regarding the production, through fermentation, of carboxylic acid, polyols, and/or polyhydroxy acid using Applicant's claimed process steps. As a result, this reference cannot serve to anticipate the claimed invention. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1-3, 6-7 and 10-13 are rejected under 35 U.S.C. § 103(a) as being obvious over Wickerham, in view of Shirai et al. (US 5,618,708). This rejection is respectfully traversed for the following reasons.

With regards to the Wickerham reference, as was noted above, this reference fails to even address the production, by fermentation, of carboxylic acids, polyols and/or polyhydroxy acids. Instead, this reference is directed strictly to a method of classifying a number of yeast strains in order to determine which are capable of utilizing various nitrogen sources. This subject matter is clearly non-analogous to the presently claimed invention.

As for the Shirai reference, it fails to contain any teaching or suggestion relating to

Appl. No.: 09/663,963
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the use of the claimed biotin component which is **substantially free of particulate matter and bacteria**. Nowhere within the four corners of the Shirai reference is this element of the claimed invention either taught or suggested. Moreover, even the use of biotin, in general, is taught as being merely optional by the Shirai reference.

Applicant respectfully states that there exists no motivation on the part of the routineer to wish to combine the teachings of Wickerham and Shirai due to the divergence in purpose related to their subject matter. The fermentation broth disclosed by Wickerham is taught as only being used for yeast strain classification purposes. There is no teaching, suggestion or motivation present in the Wickerham reference to use said fermentation medium to produce the claimed acids and polyols. It is extremely well settled that an Examiner cannot establish obviousness through references describing various aspects of an Applicant's invention unless the Examiner also provides evidence of motivating force to compel a person skilled in the art to do what Applicant has done. See, Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The requisite evidence of motivating force is not believed by Applicant to exist since the two references are clearly directed to accomplishing different goals, i.e., yeast analysis/classification versus body tissue component/inositol growth.

It has been held that absent a recognition in the art of a potential problem, it is difficult to perceive from whence stems the requisite motivation to take preventive action. See, Ex parte GPAC Inc., 29 U.S.P.Q.2d 1401 (Bd. Pat. App. & Inter. 1993) at 1416. The present invention is directed to providing a process with which high quality, i.e., color and odor stable, acids and polyols may be made in a cost-efficient manner. Neither reference relied upon by the Examiner is even remotely concerned with achieving this goal. As a result, one of ordinary skill in the art would clearly lack the motivation to want to combine these references in order to arrive at the claimed process.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of

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this rejection is respectfully requested.

It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,



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